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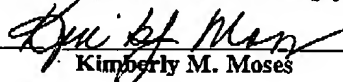
002/017

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/784,415 Confirmation No: 1870  
Applicant: Randal T. Byrum Filed: 02/20/2004  
TC/A.U.: 3738 Examiner: Thomas Sweet  
Docket No.: END5265USNP Customer No.: 000027777

Title: A METHOD FOR IMPLANTING AN ADJUSTABLE BAND

I hereby certify that this correspondence is being facsimile transmitted to the  
United States Patent And Trademarks Office.

  
Kimberly M. Moses

9-29-06  
Date

Attention: Office of Petitions  
Mail Stop Petition  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

PETITION FOR REVIVAL OF AN APPLICATION  
FOR PATENT ABANDONED UNINTENTIONALLY UNDER 37 CFR 1.137(b)

The above-identified application became abandoned for failure to file a timely and proper reply to a notice or action by the United States Patent and Trademark Office. The date of abandonment is the day after the expiration date of the period set for reply in the Office notice or action plus an extensions of time actually obtained.

Applicant hereby petitions for the revival of the above-identified application.

## 1. Petition fee

☐ Small entity- fee \$ \_\_\_\_\_ (37 CFR 1.17(m)). Applicant claims small entity status. See 37 CFR 1.27.

☒ Other than small entity-fee \$1,500.00 (37 CFR 1.17(m))

## 2. Rely and/or fee

a. The reply and /or fee to the above-noted Office action:

10/02/2006 MBINAS 00000025 100750 10784415  
01 FC:1453 1500.00 DA

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003/017

- ☐ has been filed previously on \_\_\_\_\_  
☒ is enclosed herewith.

b. The Issue of \$ \_\_\_\_\_

- ☐ has been paid previously on \_\_\_\_\_  
☐ is enclosed herewith.

3. Terminal disclaimer with disclaimer fee

- ☐ Since the utility/patent application was filed on or after June 8, 1995, no terminal disclaimer is required.

- ☐ A terminal disclaimer (and disclaimer fee (37 CFR 1.20(d)) of \$ \_\_\_\_\_ for a small entity or \$ \_\_\_\_\_ for other than a small entity) disclaiming the required period of time is enclosed herewith.

4. Statement: The entire delay in filing the required reply from the due date for the required reply until the filing of a grantable petition under 37 CFR 1.137(b) was unintentional.

5. Fee payment:

- ☒ Charge the petition fee of \$1,500.00 to Account 100750/END5265USNP/DLG and for any additional fee required. A duplicate of this petition is attached.
- ☐ A check in the sum of \$ \_\_\_\_\_ is attached.
- ☒ Charge Account 100750/END5265USNP/DLG for any additional fee required.

\_\_\_\_\_/Dean L. Garner/\_\_\_\_\_  
Dean L. Garner  
Reg. No.: 35,877  
Attorney for Applicant(s)

JOHNSON & JOHNSON  
One Johnson & Johnson Plaza  
New Brunswick, NJ 08933  
Tel. No.: (513) 337-8559  
Date: September 29 2006



## UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
 United States Patent and Trademark Office  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,415	02/20/2004	Randal T. Byrum	END-5265NP	1870
27777	7590	02/02/2006	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3738	

DATE MAILED: 08/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

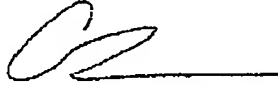
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<b>Notice of Abandonment</b>	Application No.	Applicant(s)	
	10/784,415	BYRUM, RANDAL T.	
	Examiner	Art Unit	
	Thomas J. Sweet	3738	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

This application is abandoned in view of:

- ☒ Applicant's failure to timely file a proper reply to the Office letter mailed on 22 November 2005.
  - ☐ A reply was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply (including a total extension of time of \_\_\_\_\_ month(s)) which expired on \_\_\_\_\_.
  - ☐ A proposed reply was received on \_\_\_\_\_, but it does not constitute a proper reply under 37 CFR 1.113 (a) to the final rejection. (A proper reply under 37 CFR 1.113 to a final rejection consists only of: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114).
  - ☐ A reply was received on \_\_\_\_\_ but it does not constitute a proper reply, or a bona fide attempt at a proper reply, to the non-final rejection. See 37 CFR 1.85(a) and 1.111. (See explanation in box 7 below).
  - ☒ No reply has been received.
- ☐ Applicant's failure to timely pay the required issue fee and publication fee, if applicable, within the statutory period of three months from the mailing date of the Notice of Allowance (PTOL-85).
  - ☐ The issue fee and publication fee, if applicable, was received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the statutory period for payment of the issue fee (and publication fee) set in the Notice of Allowance (PTOL-85).
  - ☐ The submitted fee of \$\_\_\_\_\_ is insufficient. A balance of \$\_\_\_\_\_ is due.  
The issue fee required by 37 CFR 1.18 is \$\_\_\_\_\_. The publication fee, if required by 37 CFR 1.18(d), is \$\_\_\_\_\_.
  - ☐ The issue fee and publication fee, if applicable, has not been received.
- ☐ Applicant's failure to timely file corrected drawings as required by, and within the three-month period set in, the Notice of Allowability (PTO-37).
  - ☐ Proposed corrected drawings were received on \_\_\_\_\_ (with a Certificate of Mailing or Transmission dated \_\_\_\_\_), which is after the expiration of the period for reply.
  - ☐ No corrected drawings have been received.
- ☐ The letter of express abandonment which is signed by the attorney or agent of record, the assignee of the entire interest, or all of the applicants.
- ☐ The letter of express abandonment which is signed by an attorney or agent (acting in a representative capacity under 37 CFR 1.34(a)) upon the filing of a continuing application.
- ☐ The decision by the Board of Patent Appeals and Interference rendered on \_\_\_\_\_ and because the period for seeking court review of the decision has expired and there are no allowed claims.
- ☐ The reason(s) below:

  
 CORRINE McDERMOTT  
 SUPERVISORY PATENT EXAMINER  
 TECHNOLOGY CENTER 3700

Petitions to revive under 37 CFR 1.137(a) or (b), or requests to withdraw the holding of abandonment under 37 CFR 1.181, should be promptly filed to minimize any negative effects on patent term.

U.S. Patent and Trademark Office  
PTOL-1452 (Rev. 04-01)

Notice of Abandonment

Part of Paper No. 20080731



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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/784,415	02/20/2004	Randal T. Byrum	END-5265NP	1870
27277	1540	11/03/2005	EXAMINER	
PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			SWEET, THOMAS	
			ART UNIT	PAPER NUMBER
			3733	

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	Application No.	Applicant(s)	
	10784,415	BYRUM, RANDAL T.	
	Examiner	Art Unit	
	Thomas J. Sweet	3738	

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
 Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date 02/20/2006

- 4) ☐ Interview Summary (PTO-613)  
 Paper No(s)/Mail Date, \_\_\_\_

- 5) ☐ Notice of Informal Patent Application (PTO-81)  
 6) ☐ Other

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Application/Control Number: 10/784,415

Page 2

Art Unit: 3738

## DETAILED ACTION

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(e) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Benchetrit (US 6,916,326). Benchetrit discloses a method for implanting surgical device (fig. 1), said method comprising: a. providing a surgical device comprising an elongated flexible inflatable portion (2), an elongated flexible and substantially inextensible band portion (1, inherently inextensible to the point that it must retain 2 while in use) having a distal end, a proximal end and a longitudinal axis therebetween, said band portion being attached to said inflatable portion (form in a single piece, col 6) along an inner face thereof, said band portion having a concave cross section (as seen at the edges thereof in the fig. 1 embodiment, conforms to the 2 profile), taken perpendicular to said longitudinal axis; and b. deforming said band so that it has a substantially flat (read as flatter than original) cross section

Application/Control Number: 10/784,415

Page 3

Art Unit: 3738

(fully capable and inherent in the fig. 1 embodiment since the additional thickness of 1 on 2 would resist expansion when 2 inflates, there by flattening 1 as 2 bulges), taken perpendicular to said longitudinal axis, by encircling said band around body tissue (and inflating).

With regard to claims 2-5 and 7-9, as disclosed in use of the Benchetrit device and seen in the figures.

With regard to claim 6, the means for attaching said distal and proximal ends of said band together is 16 and its related parts.

#### *Conclusion*

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Egle (US PGpub 2004/0260319), DiForte (US 5,382,184), Thompson et al. (US 6,634,533), Miller (US 5,509,888), Scorvo (US PGpub 2004/0242956) and Jakobsson et al. (US 6,102,922).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Sweet whose telephone number is 571-272-4761. The examiner can normally be reached on 6:30 am - 5:00pm, M-Th.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine M. McDermott can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

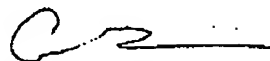


Application/Control Number: 10/784,415  
Art Unit: 3738

Page 4

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

tjs



CORRINE McDERMOTT  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3700

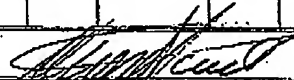
PTO/SB08A (08-00)  
Approved for use through 10/31/2002. OMB 0651-0001  
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Substitute for form 1449A/PTO

<b>INFORMATION DISCLOSURE STATEMENT BY APPLICANT</b> (Use as many sheets as necessary) Sheet 1 of 1	<table border="1" style="width: 100%;"> <tr> <td>Application Number</td> <td></td> </tr> <tr> <td>Filing Date</td> <td>February 20, 2004</td> </tr> <tr> <td>First Named Inventor</td> <td>Randal T. Byrum</td> </tr> <tr> <td>Group Art Unit</td> <td></td> </tr> <tr> <td>Examiner Name</td> <td></td> </tr> <tr> <td>Attorney Docket Number</td> <td>END-S265NP</td> </tr> </table>	Application Number		Filing Date	February 20, 2004	First Named Inventor	Randal T. Byrum	Group Art Unit		Examiner Name		Attorney Docket Number	END-S265NP
Application Number													
Filing Date	February 20, 2004												
First Named Inventor	Randal T. Byrum												
Group Art Unit													
Examiner Name													
Attorney Docket Number	END-S265NP												

U.S. PATENT DOCUMENTS						
Examiner Initials	Cite No. <sup>1</sup>	U.S. Patent Document		Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear
		Number	Kind Code <sup>2</sup> (if known)			
2		Re. 36176		Kuzmak	03-30-1999	ALL
		4,592,399		Kuzmak et al.	06-03-1986	ALL
		5,226,429		Kuzmak	07-13-93	ALL
		5,601,604		Vincent	02-11-1997	ALL
		6,102,922		Jakobsson et al.	08-15-2000	ALL
		6,453,907	B1	Forsell	09-24-2002	ALL
		6,461,292	B1	6,470,892	10-29-2002	ALL
		6,470,892	B1	Forsell	10-29-2002	ALL
		2003/0105385	A1	Forsell	06-05-2003	ALL
		2003/0114729	A1	Forsell	06-19-2003	ALL

FOREIGN PATENT DOCUMENTS								
Examiner Initials	Cite No. <sup>1</sup>	Foreign Patent Document			Name of Patentee or Applicant of Cited Document	Date of Publication of Cited Document mm-dd-yyyy	Pages, Columns, Lines, where relevant passages or relevant figures appear	†
		Office <sup>3</sup>	Number <sup>4</sup>	Kind Code <sup>5</sup>				
Examiner Signature						Date Considered	10/20/05	

\* EXAMINER: Initial U reference considered, whether or not citation is in conformance with MPEP 609. Draw line through citation if not in conformance and not considered. Include copy of this form with next communication to applicant.  
<sup>1</sup> Unique citation designation number. <sup>2</sup> See attached Kinds of U.S. Patent Documents. <sup>3</sup> Enter Office that issued the document, by the two-letter code (WIPO Standard ST.3). <sup>4</sup> For Japanese patent documents, the indication of the year of the reign of the Emperor must precede the serial number of the patent document. <sup>5</sup> Kind of document by the appropriate symbols as indicated on the document under WIPO Standard ST. 16 if possible. <sup>6</sup> Applicant is to place a check mark here if English language Translation is attached.  
 Burden Hour Statement: This form is estimated to take 2.0 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U. S. Patent and Trademark Office, Washington, DC 20231.  
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<b>Notice of References Cited</b>	Application/Control No. 10/784,415	Applicant(s)/Patent Under Reexamination BYRUM, RANDAL T.	
	Examiner Thomas J. Sweet	Art Unit 3738	Page 1 of 1

## U.S. PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,916,326	07-2005	Benchetrit, Salomon	606/151
*	B	US-2004/0260319	12-2004	Egle, Walter	606/157
*	C	US-5,382,184	01-1995	DiForte, Jr., Mario P.	441/108
*	D	US-6,634,533	10-2003	Thompson et al.	224/641
*	E	US-5,509,888	04-1996	Miller, Paul L.	600/29
*	F	US-2004/0242956	12-2004	Scorvo, Sean K.	600/030
*	G	US-6,102,922	08-2000	Jakobsson et al.	606/157
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

## FOREIGN PATENT DOCUMENTS

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

## NON-PATENT DOCUMENTS

*		Include as applicable: Author, Title Data, Publisher, Edition or Volume, Pertinent Pages)
	U	
	V	
	W	
	X	

\* A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a).)  
 Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

U.S. Patent and Trademark Office  
 PTO-892 (Rev. 01-2001)

Notice of References Cited

Part of Paper No. 11162005